

REMARKS

Claims 127-202 are pending in the application.

Office Action of December 5, 2003

In an Office Action on December 5, 2003, the Office rejected claims 127-202 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,070,150 to Remington et al. ("the Remington patent") in view of Electronic Funds Transfer Project, Final Report, Washington State, October 1994. In a Reply on June 2, 2004, Applicant traversed each of these rejections. In the June 2, 2004 Reply, Applicant argued that the Remington patent cannot render any of the present claims obvious, alone or in combination, at least because the Remington patent does not qualify as prior art to the present application. In support of this contention, Applicant submitted three declarations: (1) a Declaration under 37 C.F.R. § 1.131 executed by Mr. John Polk ("the initial Polk declaration"), the named inventor of the claimed subject matter; (2) a Declaration under 37 C.F.R. § 1.131, executed by Mr. Richard Vesper; and (3) a Declaration under 37 C.F.R. § 1.131, executed by Mr. Lionel M. Lavenue.

Applicant argued that these three declarations established that conception of the claimed invention occurred prior to October 18, 1996, the filing date of the Remington patent. In addition, Applicant argued that the declarations established that reasonable diligence was exercised by the inventor and the attorneys preparing the application from a date prior to October 18, 1996 through September 30, 1997, the filing date of U.S. patent application No. 08/941,187, the great-grandparent of the present application ("the '187 application"). The present application is a continuation of U.S. Patent Application No. 09/413,862, filed October 7, 1999, which is a continuation of 09/003,941, filed

January 7, 1998, now U.S. Patent No. 6,119,107, which is a divisional of the '187 application, now U.S. Patent No. 5,946,669.

Office Action of October 12, 2004

In the present Office Action, dated October 12, 2004, the Examiner stated that "[t]he Declaration filed on June 02, 2004 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the Remington et al (6,070,150) reference."¹ Office Action, p. 2. The Examiner further alleged that: "The exhibits filed failed to establish the conception of the claimed subject matter in the . . . application." Id. In particular, the Examiner alleged that the exhibits to the initial Polk declaration failed to teach three "items set forth in claims 127-202," namely:

1. Payment information including a debit transaction.
2. Transmitting the payment information from the accumulator agency to a bank.
3. Transmitting the disbursement information from the accumulator agency to an intermediary.

Id.

Respectfully, Applicant disagrees with the Examiner's conclusion.

With regard to the second and third items cited by the Examiner, those features are simply not present in any of the pending claims, i.e., claims 127-202. In particular, none of the claims recite either (2) transmitting payment information from an accumulator agency to a bank or (3) transmitting disbursement information from an

¹ Although three declarations were filed in the preceding Reply, Applicant understands the Examiner's reference to "the Declaration" as a reference to the initial Polk declaration.

accumulator agency to an intermediary. Because pending claims 127-202 do not recite these features, the conception of these features are irrelevant to the patentability of claims 127-202. Thus, the Examiner's rejections on these grounds are improper.

With regard to the first item cited by the Examiner, i.e., (1) payment information including a debit transaction, Applicant is uncertain as to how to respond to the Examiner's rejection of pending claims 127-202. For example, pending independent claim 127 recites a method including requesting an employer of an employee to withdraw a child support obligation from a salary of the employee via an accumulator agency, wherein the accumulator agency processes a child support payment as a debit-based transaction. Although the Examiner does not directly address this (or any) claim element in the Office Action, he does allege that the initial Polk declaration and exhibits failed to establish conception of payment information including a debit transaction.

The language in the Examiner's Office Action is different from the language recited in the pending claims. The Examiner refers to "payment information including a debit transaction," but the pending claim language is directed specifically to a child support payment (not generally to payment information) and is directed specifically to processing as a debit-based transaction (not generally to "including a debit transaction"). In Applicant's view, these are different, and the Examiner's position regarding conception of denoted item (1) is distinguishable from the claimed features. For this reason as well, the Examiner's rejections on this basis are also incorrect.

Accordingly, because the Examiner's rejections of pending claims 127-202 are based on either improper rejections (i.e., that do not mention the claim elements) or

incorrect (i.e., that are based on features different from those recited in the claims), Applicant requests that the Examiner kindly reconsider his position and allow the claims.

Furthermore, it is possible that the Examiner meant that if the initial Polk declaration and exhibits failed to establish conception of "payment information including a debit transaction," then they also failed to establish conception of a method including requesting an employer of the employee to withdraw a child support obligation from a salary of an employee via an accumulator agency, wherein the accumulator agency processes a child support payment as a debit-based transaction. Based on this possibility,² Applicant addresses the conception of (1) payment information including a debit transaction below. Further, to fully respond to the Office Action, Applicant also addresses the conception of (2) transmitting payment information from an accumulator agency to a bank and (3) transmitting disbursement information from an accumulator agency to an intermediary, although these are not recited in any of the pending claims.

Supplemental Polk Declaration

Applicant files herewith a Supplemental Declaration of John Polk under 37 C.F.R. § 1.131 ("the supplemental Polk declaration"), executed by Mr. Polk. Attached to the supplemental Polk declaration are two exhibits, Exhibit 1, entitled "Exhibit 1 The Problem Defined," and Exhibit 2, entitled "Exhibit 1 Electronic Processing of Wage

² If the Examiner intended to make a different argument in rejecting claims 127-202, Applicant respectfully requests that the Examiner set forth that argument and withdraw the finality of the Office Action in order to afford Applicant the opportunity to fully respond to the intended claim rejections.

Assignments.”³ Together with the knowledge of one skilled in the art at the time of the invention, these documents evidence conception of at least the three items listed by the Examiner, specifically including (1) payment information including a debit transaction, (2) transmitting payment information from an accumulator agency to a bank, and (3) transmitting disbursement information from the accumulator agency to an intermediary. See Suppl. Polk Decl. ¶¶ 6-9.

The Examiner contends that the initial Polk declaration failed to teach: (1) payment information including a debit transaction. However, as shown in the supplemental Polk declaration, Exhibit 2 teaches this item. Suppl. Polk Decl. ¶ 7. Mr. Polk explains as follows: “The reference to use of the ‘Formatted 521 Records’ by the accumulator agency clearly demonstrates two things: (1) use of a debit transaction (not a credit transaction) and (2) processing of the debit transaction to a bank.” Suppl. Polk Decl. ¶ 8. Mr. Polk further explains: “Therefore, the reference in Exhibit 2 to ‘the accumulator/router function permits the receipt and routing of electronic payment transactions from employers’ via ‘Formatted 521 Records’ clearly indicates a debit transaction, which is processed by the accumulator agency. (Emphasis added.)” Id. Thus, the supplemental Polk declaration clearly shows that the exhibits at issue establish the conception of payment information including a debit transaction.

³ The Examiner correctly recognizes: “It should be noted that both pieces of documentary evidence are listed as ‘Exhibit 1.’” Indeed, both of the original documents were identified as “Exhibit 1” when they were created by Mr. Polk prior to October 18, 1996. For ease of reference, we refer to the first exhibit as “Exhibit 1” and to the second exhibit as “Exhibit 2” herein, as indicated by the cover sheets preceding the exhibits.

The Examiner contends that the initial Polk declaration failed to teach: (2) transmitting payment information from an accumulator agency to a bank. However, as shown in the supplemental Polk declaration, Exhibits 1 and 2 teach this item from the claims. Suppl. Polk Decl. ¶ 9. Mr. Polk explains as follows: "Exhibits 1 and 2 also describe transmitting payment information from an accumulator agency to a bank due to the reference to 'the accumulator/router function permits the receipt and routing of electronic payment transactions from employers . . . [via] Formatted 521 Records.'" Mr. Polk further explains: "One of ordinary skill in the art would have known that that 'Formatted 521 Records' always require a bank for processing; in fact, a debit transaction requires two banks (the bank for the originator and the bank for the debtor)." Id. Mr. Polk still further explains: "In order for the accumulator agency depicted in Exhibit 2 to 'route' electronic payments (e.g., to process payment information) in this 'closed loop operation,' the payments must be sent to a bank." Suppl. Polk Decl. ¶ 10. Thus, the supplemental Polk declaration clearly shows that the exhibits at issue establish the conception of transmitting payment information from an accumulator agency to a bank.

The Examiner contends that the initial Polk declaration failed to teach: (3) transmitting disbursement information from the accumulator agency to an intermediary. However, as shown in the supplemental Polk declaration, Exhibits 1 and 2 teach this item. Suppl. Polk Decl. ¶ 11. Mr. Polk explains as follows: "Thus, Exhibit 1 clearly depicts the transmission of wage assignments from employers to a designated state (i.e., the 'state child support agency' depicted in Exhibit 1, and e.g., 'the intermediary' of claims 145-252)." Id. Mr. Polk further explains: "As shown in Exhibit 2, the solution

offered by the accumulator agency was to separate the wage assignment orders into two parts, the record (e.g., 'the disbursement information' of claims 145-252) and the electronic payment (e.g., the 'payment information' of claims 145-252)." Id. Mr. Polk still further explains: "In this closed loop operation, the accumulator also processes disbursement information to the intermediary designated in the wage assignment order. On review of Exhibits 1 and 2, one of ordinary skill in the art would readily understand both of these processes performed by the accumulator agency, specifically including transmitting disbursement information from the accumulator agency to an intermediary." Id. Thus, the supplemental Polk declaration clearly shows that the exhibits at issue establish the conception of transmitting disbursement information from the accumulator agency to an intermediary.

As demonstrated by the supplemental Polk declaration, the exhibits at issue (i.e., Exhibits 1 and 2) established the conception of (1) payment information including a debit transaction, (2) transmitting payment information from an accumulator agency to a bank, and (3) transmitting disbursement information from the accumulator agency to an intermediary.

Conclusion

For the reasons stated above, the Examiner's rejections of claims 127-202 are either improper (i.e., as not mentioning the claim elements) or incorrect (i.e., as based on features different from those actually recited in the claims). Accordingly, Applicant requests that the Examiner withdraw the rejections and allow the pending claims.

Additionally, although Applicant is uncertain exactly how the Examiner meant to relate the three recited items listed in the Final Office Action to the language of claims 127-202, the supplemental Polk declaration and accompanying exhibits, in combination with the declarations and exhibits filed with the June 2, 2004 Reply to Office Action, also establish conception of the three items prior to the filing date of the Remington patent. Therefore, the Remington patent is not a prior art reference even if any of the listed items is present in claims 127-202. Accordingly, for these reasons as well, all the rejections of claims 127-202 should be withdrawn with respect to the Remington patent.

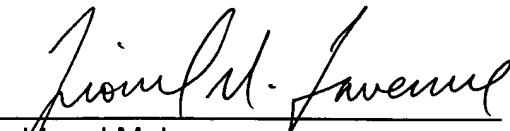
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 12, 2005

By: _____


Lionel M. Lavenue
Reg. No. 46,859

Attachment: Supplemental Declaration of John Polk under 37 C.F.R. § 1.131
with Exhibits 1-2



PATENT
Customer Number 22,852
Attorney Docket No. 06556.0003-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
John POLK)
Serial No.: 09/973,865) Group Art Unit: 3629
Filed: October 11, 2001) Examiner: John WEISS
For: METHODS AND APPARATUS)
FOR CHILD SUPPORT)
PAYMENT PROCESSING AND)
CHILD SUPPORT)
DISBURSEMENT)
PROCESSING)

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL DECLARATION OF JOHN POLK UNDER 37 C.F.R. § 1.131

1. I, John Polk, am the Applicant of the above-identified application and the inventor of the subject matter described and claimed therein, and I executed and filed a Declaration to that effect on September 29, 1997. In response to an Office Action dated December 5, 2003 in the above-identified application, I also prepared a "Declaration of John Polk Under 37 C.F.R. § 1.131," which I executed on May 28, 2004. Therein, I described facts about the conception of the subject matter of this patent application.

2. It is my understanding that, in a subsequent Office Action dated October 12, 2004, the Patent Office took the position that my declaration (and the cited exhibits) failed to teach three features allegedly set forth in claims 127-202. Specifically, the Patent Office contended that my declaration (and the cited exhibits) did not disclose the following three features: (1) payment information including a debit transaction; (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary.

3. I am uncertain how the Examiner believes these three features are represented in the pending claims of the present application because the language used by the Examiner is not found in any of pending claims 127-202. For example, these features do not appear in the claims in any form: (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary. Further, the following feature also does not appear in any claim, although the Examiner may have intended otherwise: (1) payment information including a debit transaction. It is my understanding that the Examiner may have intended, for example, that "payment information including a debit transaction" is a feature of claim 127, which does recite a method including "requesting an employer of an employee to withdraw a child support obligation from a salary of the employee via an accumulator agency, wherein the accumulator agency processes a child support payment as a debit-based transaction." However, despite this possible intention, this argument is not made in the Office Action.

4. I disagree that any of the three features recited by the Examiner are present in the pending claims. Features (2) and (3) are clearly not present, and even feature (1) is entirely different. Claim 127 is directed specifically to a "child support payment" and an accumulator agency that "processes a child support payment as a debit-based transaction." These elements of claim 127 are different from recited feature (1).

5. Nonetheless, regardless of how the Examiner intended to relate the three listed features from the Office Action to the claims of the present application, I further disagree with the Examiner's assertion that my declaration and the cited exhibits failed to teach the cited features. In this supplemental declaration, I address each of these three features and explain how these features were indeed disclosed by my declaration.

6. Exhibits 1 and 2, which were both attached to my initial declaration of May 28, 2004, are true and correct copies of drawings that I prepared prior to October 18, 1996. Those drawings depict aspects of my invention of an accumulator agency for electronically processing wage assignments (i.e., wage assignment orders) from states for employers. See Exhibits 1 and 2 to "Declaration of John Polk Under 37 C.F.R. § 1.131". Copies of these two drawings are attached hereto as Exhibits 1 and 2.

7. Exhibit 1 (entitled "Exhibit 1 The Problem Defined") and Exhibit 2 (entitled "Exhibit 1 Electronic Processing of Wage Assignments") are documentary evidence of conception of at least the three features cited in the October 12, 2004 Office Action. As explained below, Exhibits 1 and 2 teach each of the following three features identified by the Patent Office: (1) payment information including a debit transaction; (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary.

8. First, Exhibits 1 and 2 describe payment information including a debit transaction, particularly given the reference to the "Formatted 521 Records" in Exhibit 2. Exhibit 1 defines the problem of multiple withholding orders from states to employers, and Exhibit 2 describes the solution to the problem, namely, the use by employers of an "accumulator router function" (e.g., an "accumulator agency"). As shown in Exhibit 2, the accumulator agency receives and processes wage assignment orders from states for employers. The textual description at the bottom of Exhibit 2 describes the two parts of a wage assignment order, the record (e.g., "disbursement information") and the electronic payment (e.g., "payment information"). The textual description at the bottom of Exhibit 2 also describes the subsequent processing of the disbursement information and of the payment information by the accumulator agency. In particular, the accumulator agency processes the disbursement information from the employer to the designated state (e.g., an "intermediary"), and the accumulator agency also processes the payment information from the employer to a bank via "Formatted 521 Records."

9. The reference to use of the "Formatted 521 Records" by the accumulator agency clearly demonstrates two things: (1) use of a debit transaction (not a credit transaction) and (2) processing of the debit transaction to a bank. One of ordinary skill in this field would have known at the time of this invention that 521 records allow for payments using either credit transactions or debit transactions. However, only a bank is able to originate a credit transaction, whereas a non-bank entity (such as, an accumulator agency) is able to originate a debit transaction. Therefore, the reference in Exhibit 2 to "the accumulator/router function permits the receipt and routing of electronic payment transactions from employers" via "Formatted 521 Records" clearly indicates a

debit transaction, which is processed by the accumulator agency. (Emphasis added.) In this scenario, the accumulator agency originates the debit transaction on behalf of the employer and the debit transaction is transmitted to the accumulator agency's bank.

10. Second, Exhibits 1 and 2 also describe transmitting payment information from an accumulator agency to a bank due to the reference to "the accumulator/router function permits the receipt and routing of electronic payment transactions from employers . . . [via] Formatted 521 Records." As described above, after a non-bank entity (such as, an accumulator agency) originates a debit transaction for an electronic payment, the electronic payment transaction is transmitted to the bank of the originator for initial processing of the debit (e.g., to the accumulator agency's bank). In this scenario, the debit transaction would then also be transmitted from the accumulator agency's bank to the bank of the debtor (e.g., to the employer's bank) via the ACH (i.e., the automated clearing house). One of ordinary skill in the art would have known that that "Formatted 521 Records" always require a bank for processing; in fact, a debit transaction requires two banks (the bank for the originator and the bank for the debtor).

11. Further, the textual description at the bottom of Exhibit 2 also explains that "[t]he combination of functions create a 'closed loop' operation." This combination of functions by the accumulator agency refers to the preceding sentence of the textual description of Exhibit 2: "the accumulator/router function permits the receipt and routing of electronic payment transactions from employers . . . [via] Formatted 521 Records." In order for the accumulator agency depicted in Exhibit 2 to "route" electronic payments (e.g., to process payment information) in this "closed loop operation," the payments must be sent to a bank. One of ordinary skill in the art would readily understand this.

12. Third, Exhibits 1 and 2 also describe transmitting disbursement information from the accumulator agency to an intermediary. As described above, the accumulator agency processes the disbursement information from the employer to the designated state (e.g., "the intermediary" of claims 145-252). As shown in Exhibit 1, the problem of multiple withholding orders from states involved "[s]tates send[ing] multiple wage withholding orders (garnishments) to employers that require the employer to adapt to the particular state(s) . . . [with] a paper-based process." Thus, Exhibit 1 clearly depicts

the transmission of wage assignments from employers to a designated state (i.e., the "state child support agency" depicted in Exhibit 1, and e.g., an "intermediary"). As shown in Exhibit 2, the solution offered by the accumulator agency was to separate the wage assignment orders into two parts, the record (e.g., "disbursement information") and the electronic payment (e.g., "payment information"). As described above, the accumulator agency then "routes . . . electronic payment transactions" (i.e., processes payment information to a bank). In this closed loop operation, the accumulator also processes disbursement information to the intermediary designated in the wage assignment order. On review of Exhibits 1 and 2, one of ordinary skill in the art would readily understand both of these processes performed by the accumulator agency, specifically including transmitting disbursement information from the accumulator agency to an intermediary.

13. For reasons that I do not understand, with regard to transmitting disbursement information from the accumulator agency to an intermediary, the Patent Office also contends in the Office Action that: "The [disbursement] information could have been sent directly from a payment agency (Bank) or from the employer." I cannot respond to that statement, as it does not address what Exhibits 1 and 2 disclose.

14. For the foregoing reasons, and based on Exhibits 1 and 2, I believe that one of ordinary skill in this field would understand Exhibits 1 and 2 to disclose the following features: (1) payment information including a debit transaction; (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary. Thus, I believe there is evidence of conception of at least these features prior to October 18, 1996, i.e., the effective date of U.S. Patent Application No. 08/734,518, titled Electronic Bill Presentment and Payment System, now U.S. Patent No. 6,070,150 ('150 Patent).

15. Accordingly, based on my initial declaration of May 28, 2004 (and the attached exhibits) and on this supplemental declaration, I, John Polk, the inventor of the subject matter described and claimed in the above-referenced patent application, conceived of the claimed invention prior to the effective date of the '150 Patent.

16. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patents issuing thereon.

Dated: _____

4/7/05

By: _____


John Polk

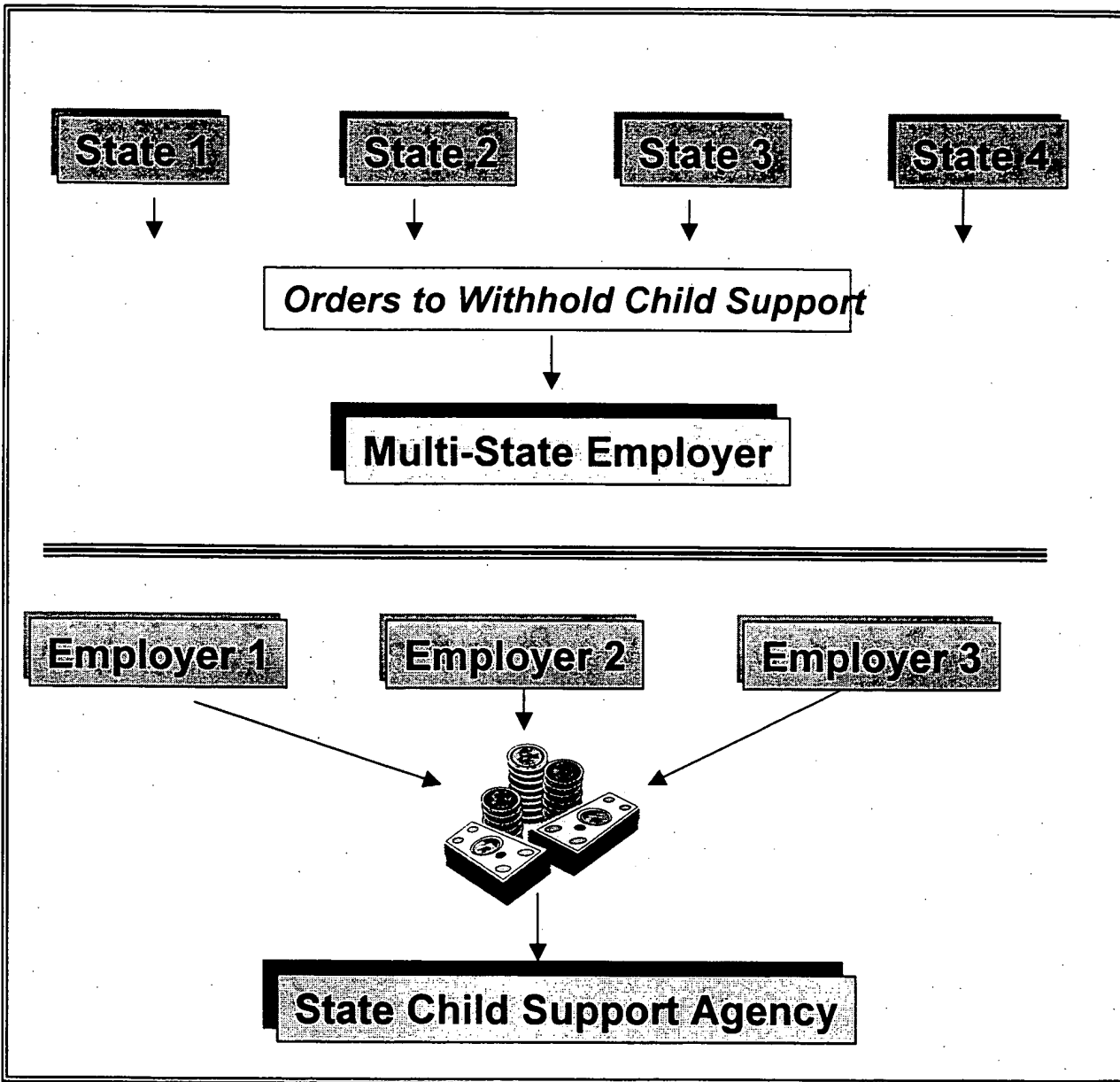
Exhibit 1

to

**Supplemental Declaration of John Polk
Under 37 C.F.R. § 1.131**

Exhibit 1

The Problem Defined



States send multiple wage withholding orders (garnishments) to employers that require the employer to adapt to the particular state(s).

The employer wants to remit child support payments in one form to all states.

The result of the "do it my way" approach has been a paper-based process.

Exhibit 2

to

**Supplemental Declaration of John Polk
Under 37 C.F.R. § 1.131**

Exhibit 1

Electronic Processing of Wage Assignments

